Supreme Court, U.S.
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MICHAEL RODAK, JR.

IN THE

Supreme Court of the United States

OCTOBER TERM, 1973

No. 73-131

PENN YAN BOATS, INC.,

Petitioner,

v.

SEA LARK BOATS, INC., DON'S MARINE CENTER, INC., and DONALD L. WOLLARD,

Respondents.

RESPONDENTS' BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

ALFRED B. ENGELBERG
50 East 42nd Street
New York, New York 10017
Attorney for Respondents

Of Counsel:

MORTON AMSTER

August 22, 1973

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Introduction

This is a conventional action for patent infringement in which Petitioner seeks a review of findings of fact made by the District Court and adopted by the Fifth Circuit Court of Appeals.

There is no issue of law as to patentability since the District Court and the Fifth Circuit specifically applied the standards enunciated by this Court in *Graham* v. *John Deere Co.*, 383 U.S. 1 (1966), to the evidence of record. Indeed, the Petition does not urge that any error of fact or law was committed with respect to the evidence which Petitioner actually presented during the trial. Petitioner's attack on the standard of patentability applied by the Fifth

Circuit is merely an attempt to disguise the fact that it seeks a *de novo* review of the Wollard patent under 35 U.S.C. 103 with respect to a prior art patent (Higgins) which Petitioner *abandoned prior to trial* and on which it made no record *at the trial* with respect to the factual inquires by *Graham, supra.*

There is no issue of law as to infringement since the District Court and the Fifth Circuit specifically applied the principles enunciated by this Court in *Graver Tank Co.* v. *Linde Air Products Co.*, 339 U.S. 605 (1950) to their findings of fact.

The True Nature of the Questions Presented for Review in View of the Proceedings Below

The record is replete with Petitioner's assertion, as plaintiff below,* that its Stuart patent was valid and that it defined a patentable tunnel propulsion system which had been widely hailed as a significant advance over the prior art. Respondents agreed that the tunnel propulsion system in controversy embodied a patentable invention and constituted a significant advance in the boating art (F.F. 6).* However, Respondents then proved at trial: that Wollard was the first inventor of this admittedly patentable tunnel propulsion system (F.F. 7-18); that the Stuart patent was invalid in view of the Wollard patent (F.F. 33-43); and, that Petitioner's boats incorporating the pat-

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* Petitioner, Penn Yan Boats, Inc., commenced this action by filing a Complaint charging Respondents Donald L. Wollard, et al with infringement of Petitioner's Stuart patent. Respondents counterclaimed charging Petitioner with infringement of the Wollard patent. The Stuart patent was held invalid, non-infringed and unenforceable because it had been procured by fraud on the United States Patent Office. Petitioner did not appeal from any of those holdings.

* The references are to be Factual Findings set forth in the District Court's Opinion which is appended to the Petition.

ented tunnel propulsion system infringed the Wollard patent (F.F. 19-28).

The record also establishes that although there was substantial agreement between the parties with respect to the extraordinary features and advantages possessed by boats incorporating the tunnel propulsion system there was substantial disagreement as to certain technical features which were responsible for the success of such boats as well as disagreement with respect to the scope, content and relevancy of the prior art. Accordingly, a major portion of the trial was devoted to technical expert testimony with respect to the prior art and the structural and functional characteristics of Petitioner's and Respondents' boats which respectively incorporated the tunnel propulsion system. Indeed, much of that testimony was based on tests in which both parties and their experts had participated prior to trial.

Petitioner's repeated assertion that its tunnel propulsion system constituted a patentable invention, and its heavy reliance on expert testimony in an attempt to resolve disputed issues of technical fact, stands in sharp contrast to the position which it took before the Fifth Circuit and which it now takes before this Court. In a total reversal of its initial position before the District Court, Petitioner (having lost its own Stuart patent) contends that its boats are substantially identical to the inboard-power tunnel boats allegedly disclosed in the Higgins patent; and that the Wollard patent is invalid under 35 U.S.C. 103 in view of the Higgins patent. Perhaps more incredible than Petitioner's about-face on the question of patentability was its failure to clearly advise the Fifth Circuit (and now this Court) that the Higgins patent, which forms the entire basis for its appellate attack on the validity and scope of the Wollard patent and on the standard of patentability in the Fifth Circuit, was not even introduced into evidence at the trial and, therefor, was not even mentioned

by a single trial witness (F.F. 29).* Any doubt with respect to the fact that Petitioner completely abandoned the Higgins patent and did not merely fail to focus on it, as suggested in the Petition, is laid to rest by the fact that Petitioner never presented a single proposed finding of fact to the District Court with respect to the Higgins patent.**

In view of the state of the trial record, the arguments with respect to the Higgins patent which were presented to the Fifth Circuit by Petitioner (and are now presented to this Court) were not based upon an allegation that the District Court committed error in failing to make the factual findings required by this Court's decision in *Graham, supra*. Petitioner could not urge that any error had been committed in view of its total failure to present any evidence or testimony to support such findings. Accordingly, Petitioner requested the Fifth Circuit to, in effect, consider the relevance of the Higgins patent *de novo* and without the benefit of any testimony, expert or otherwise, with respect to the factual inquires mandated by *Graham, supra*.

The Fifth Circuit did not, as Petitioner states, merely affirm the District Court without opinion. To the contrary, it specifically adopted the District Court's Opinion as its own opinion. That Opinion included a specific finding that no testimony or other evidence had been presented to the Court on which to base a finding that the Higgins patent rendered the Wollard patent obvious to a person of ordinary skill in the art (F.F. 29).

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*Petitioner was, however, completely aware of the Higgins patent. It was cited in the Pre-Trial Stipulation as prior art on which Petitioner *intended* to rely at the trial.

** Although the District Court adopted proposed findings of fact which had been prepared by Respondents' counsel after the trial, both sides had submitted comprehensive proposed findings of fact carefully annotated to the record, as well as memoranda of law.

In view of the undisputable facts concerning the true nature of the proceedings below, the Petition does not truly present an issue as to whether or not the Fifth Circuit departed from either the statutory standards of patentability in holding the Wollard patent valid (Petition, Question 1, p. 2) or from the usual and accepted course of judicial proceedings in adopting the District Court's Opinion (Petition, Question 2, p. 2). There is simply no testimony or evidence in the record to which the standard of patentability could have been applied and thus there is nothing on which an opinion could have been written by the Fifth Circuit. Accordingly, with respect to the patentability issues, this Petition does not seek a review of any error of law. Rather, it is a request that this Court consider the question of whether or not the Higgins patent would render the Wollard patent obvious under 35 U.S.C. 103 *de novo*, and without the benefit of any record on which to make the factual inquiries mandated by *Graham, supra*.

In attempting to make a legal issue out of the questions of equivalence and infringement (Petition, Question 3, p. 2), petitioner finds it necessary to state as "undisputed facts" two facts which totally contradict the findings actually made below (F.F. 19-28). The discussion which follows with respect to the facts actually found by the District Court establishes that the holding of infringement is amply supported by the factual findings and does not involve the misapplication of the doctrine of equivalents.

Statement of the Facts

1. The Invention.

The District Court's findings established that the Wollard patent describes and claims a novel tunnel propulsion system for high speed planing boats which enables such

boats to be operated in shallow water as well as in normal seas (F.F. 5). These significant operating characteristics are achieved by a structure including a tunnel in the bottom of the boat hull which is so constructed and arranged that it permits a propeller (ordinarily located below the bottom of a boat) to be raised to a point where its axis of rotation is substantially aligned with the longitudinal axis of the tunnel (F.F. 5, 26). It was totally unexpected that a propeller located in such a position within a tunnel would be operative since it was generally believed that a propeller, when positioned within a tunnel, could not receive a full flow of solid unaerated water; and without such full flow, the propeller would encounter such cavitation, ventilation and trubulence that it would be inoperative (F.F. 26).* Wollard's tunnel propulsion system overcame these problems by providing a structure in which: a tunnel commenced near the middle of the boat and continued through an opening in the transom at the stern of the boat; the tunnel was relatively narrow with respect to the bottom; the propeller was aligned with the longitudinal axis of the tunnel and was nearly the same diameter as the tunnel so that substantially all of the water flowing through the tunnel was delivered to the propeller; and the tunnel was provided with a rearward continuation of the top of the tunnel at the stern of the boat (F.F. 5, 19, 26).

Petitioner does not challenge the foregoing factual findings relating to the stucture and resulting operating characteristics of the Wollard invention. Nor does Petitioner dispute the key factual findings with respect to the scope of the inventive teachings of the Wollard patent (F.F. 23-

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* Any doubt about the unexpected nature of the invention is dispelled by Petitioner's own trial evidence. For example, the *Popular Mechanics* article (PX 16) opens with the following statement:

> "It couldn't be done, they said—'You can't recess a propeller in the hull of a planing boat.'"

28). Respondents acknowledge, and the District Court found (F.F. 27), that the Wollard patent only describes the invention in terms of the preferred outboard and outdrive embodiments in which the propeller, although axially aligned with the longitudinal axis of the tunnel, is located behind the tunnel. Further, Respondents admitted, and the District Court found, that the Wollard patent does not include a specific mention of the word "inboard" (F.F. 23). Despite the admitted absence of this word from the Wollard patent, the courts found that placing the propeller in the tunnel was the equivalent of placing it behind the tunnel; and that both embodiments, with the propeller fore or aft of the transom, were embraced within the teachings of the Wollard patent. The District Court concluded, based upon the expert testimony, that since the Wollard invention worked when the propeller was located aft of the tunnel exit, there must also be a full flow of water of suitable kind and quality in the tunnel between its entrance and exit; and any person skilled in the art would immediately realize that the unique tunnel propulsion system would work, at least as well, if the propeller were located closer to the tunnel entrance, i.e., in the tunnel forwardly of the transom or stern of the boat (F.F. 27). As succinctly stated in the District Court's findings (F.F. 41):

> "The outboard embodiment is the true test of the concept and renders the inboard embodiment obvious."

Claims 18 to 20 of the Wollard patent, unlike Claims 1 to 17, are not, by their words, limited to outboard power means or to a propeller which is located behind the tunnel; they require only "power means" and a propeller shaft located above the bottom of the boat and including an axis of rotation substantially aligned with the longitudinal axis of the tunnel (F.F. 19-21). In view of this factual finding with respect to the scope of the Wollard patent, the District Court refused to give Claims 18 to 20 of the Wollard patent a narrow and nonliteral interpretation which would

have had the effect of eliminating this obvious mechanical equivalent.

Since Petitioner cannot rebut the factual finding of equivalence with respect to the location and function of the propeller, it is presumptious for Petitioner to assert to this Court, as if it were a fact, that "There are two kinds of tunnel boats . . ." (Petition, p. 5) or further to assert in its statement of the questions presented for review that Petitioner's boats have not been found by any court to be equivalent to the boats which are disclosed in the Wollard patent.*

2. The Prior Art.

During the trial, Petitioner contended that the Wollard patent was invalid or that its scope should be limited to include only those boats which have an outboard propeller in view of the 1929 *Sandpiper* publication which illustrated a boat named "Sandy" (PX 44, Tab 11H). The record and findings with regard to the "Sandy" place Petitioner's unsupported argument concerning an erroneous standard of patentability in proper focus in several respects. First, a comparison of the Higgins patent with the "Sandy"** demonstrates why Petitioner discarded the Higgins patent prior to trial. At best, the Higgins patent is merely cumulative and adds nothing to the teaching of "Sandy". Second, this Petition does not assert that the courts below applied an erroneous standard

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* The stress placed on the mechanical aspects of the "power means" by Petitioner stands in sharp contrast with the fact that in its own Stuart patent, held by the District Court to be directed to the same tunnel propulsion system, the "power means" was deemed so inconsequential that none of the Stuart claims even bothered to include "power means". However, all of the Stuart claims defined the axial location of the propeller with respect to the tunnel.

** Illustrations of each boat are reproduced in the Appendix at the end of this Brief.

of patentability with respect to the "Sandy". Third, the conflicting testimony of the experts as to what a person skilled in the art would learn from the "Sandy", and the failure of the testimony concerning the "Sandy", by Petitioner's expert to withstand cross-examination, serve to illustrate the difficulties which can be encountered, even by those skilled in the art in analyzing prior art and properly construing its relevance (F.F. 30). Yet, Petitioner now asks this Court to entertain this Petition on the ground that the Fifth Circuit departed from the controlling standards of patentability based only on an advocate's interpretation of the prior art and without the benefit of any expert testimony, all in the face of a strong inference that Petitioner's trial expert considered this discarded prior art to be, at best, cumulative (F.F. 29).

(a) The 1929 *Sandpiper* Publication.

The "Sandy", as described in the *Sandpiper* publication is a 22 foot shallow-V runabout capable of travelling at a rate of about 22 to 25 miles per hour. The drawing reproduced in the Appendix is a cross-section of the "Sandy" and illustrates its general structural features. The "Sandy" includes a hull which has a forefoot portion and a transom; a tunnel in the bottom of the hull which extends rearwardly of the forefoot portion to a bear opening in the transom; power means in the form of an inboard engine and a propeller shaft including a propeller on the end of the shaft. In these respects only, the "Sandy" includes a structure which is generally defined by Claim 18 of the Wollard patent. However, the District Court found, based on expert testimony that:

i. The propeller shaft of the "Sandy" extended below the bottom of the boat;

ii. The propeller shaft did not have its axis of rotation substantially aligned with the longitudinal axis of the tunnel;

iii. The flow of water through the tunnel would not be delivered to the propeller since only a small part of the propeller was even in the tunnel and there was no suggestion that the propeller be nearly he same diameter as the tunnel; and

iv. There was no rearward continuation of the top of the tunnel aft of the stern.

Thus, despite the superficial similarities between the "Sandy" and Wollard Claim 18, the District Court found based upon expert testimony, that there were significant structural differences between the "Sandy" and the claims of the Wollard patent; that the "Sandy" would not function in the manner taught and defined by the Wollard patent or achieve the results of Wollard's tunnel propulsion system; and that there was nothing in the description of the "Sandy" to suggest that these differences would have been obvious to a person of ordinary skill in the art at the time of the Wollard invention (F.F. 30).

(b) The Higgins Patent.

A comparison of the Higgins patent with the "Sandy" will immediately establish that the Higgins boat suffers from the same enumerated deficiencies as the "Sandy"; and that there is no disclosure in the Higgins patent which would suggest the substantial modifications of the Higgins boat which would be necessary in order to obtain Wollard's novel tunnel propulsion system. Although the Higgins boat, like the "Sandy", is a high speed boat designed for shallow draft operation, *it does not even include a tunnel which could partially house a propeller* (as did the "Sandy"). The so-called "tunnel" of Higgins is not a tunnel at all—rather, it is a "trough" or a "semi-tunnel" which permits the propeller to be mounted "closer" to the bottom of the boat. The tunnel is not large enough to house a

propeller and Higgins specifically states (PX 44 Tab IC, Col. 2, lines 34-39):

> "... that the path of the propeller blades may be made to intersect* the cross-sectional area of the tunnel."

Obviously, since the propeller is not within the semi-tunnel of Higgins, the flow of water through the semi-tunnel is not delivered to the propeller.

3. Petitioner's Boat.

A comparison of Petitioner's boat with Wollard Claim 18 and with the "Sandy" or the Higgins patent, establishes that Petitioner's boat infringes the Wollard patent as the District Court found and is not like the prior art boats.

Petitioner's boat, like the Wollard patent, is directed to a power boat designed for high speed, shallow draft operation (PX 1, Col. 1, line 61).

Petitioner's boat, like the Wollard patent, includes a hull having a full tunnel which extends from an entrance located aft of the forefoot portion through a tunnel opening in the transom at the sterm of the boat. The "Sandy" meets this limitation but the Higgins patent which has only a semi-tunnel does not.

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*It is clear from Higgins' drawings that the propeller 11 is completely outside the semi-tunnel and is actually located between the skeg keel 7 and the bottom of the boat in the stern region of the boat. The bottom of the semi-tunnel, which is also the bottom of the boat, is not identified with a numeral in Figure 1 of Higgins, but is clearly the nearly horizontal line which the top tip of the propeller appears to touch. In the Appendix, Respondents have shaded the tunnel in blue and the propeller in red so that the relationship between the tunnel and the propeller is highlighted.

Petitioner's boat, like the Wollard patent, includes a propeller shaft which is substantially above the bottom of the boat and has an axis of rotation which is substantially aligned with the longitudinal axis of the tunnel. The propeller shaft ". . . surrounds an inboard propeller . . ." and ". . . is practically parallel to the keel . . ." (according to Petitioner's advertising literature, PX 18). The propeller shaft in the Higgins patent and the "Sandy" are not axially aligned with the longitudinal axis of the tunnel; and, in each instance, the propeller is either completely or almost completely outside of the tunnel.

Petitioner's boat, like the Wollard patent, has a tunnel which is relatively narrow with respect to the bottom so that substantially all of the flow through the tunnel is delivered to the propeller. The propellers in the prior art boats are not housed within a tunnel and those boats obviously cannot deliver a flow of water *through the tunnel* to the propeller.

Petitioner's boat is not like the prior art. Rather, it includes all of the essential structure set forth in Claim 18 of the Wollard patent; it functions in the same manner; and, in sum, it incorporates the unique tunnel propulsion system of the Wollard patent.

ARGUMENT

1. This Case Does Not Raise Any Issue with Respect to the Standard of Patentability Applied by the Fifth Circuit.

In *Graham* v. *John Deere, supra,* this Court stated (383 U.S. at p. 17):

> "While the ultimate question of patentability is one of law, *A & P Tea Co.* v. *Supermarket Corp., supra,*

> at 155, 87 U.S.P.Q. at 307, the Section 103 condition, which is but one of three conditions each of which must be satisfied lends itself to *several basic factual inquiries*. Under Section 103, the scope and content of the prior art are to be determined; differences between the prior art, and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or non-obviousness of the subject matter is determined." (Emphasis added)

In further commenting on the nature of the inquiry which must be made in each case this Court went on to state:

> "This is not to say, however, that there will not be difficulties in applying the non-obviousness test. What is obvious is not a question upon which there is likely to be uniformity of thought in every given factual context. The difficulties, however, are comparable to those encountered daily by the Courts in such frames of reference as negligence and scienter, and should be amendable to a case-by-case development."

No testimony, or other evidence with respect to the factual inquiries mandated by this Court was ever offered by Petitioner with respect to the Higgins patent. It is, therefore absurd for Petitioner to suggest that error was commited by the Fifth Circuit in failing to write an opinion which discussed the standard of patentability as specifically applied to the Higgins patent. There was simply no evidence in the trial record on which to base any such discussion. In essence, Petitioner is now urging that its own action in discarding the Higgins patent before trial, and then attempting to resurrect the Higgins patent on appeal placed a heavier burden of "review" on the Fifth Circuit than it would have had if Petitioner had taken testimony and requested findings from the District Court with respect to the Higgins patent.

Petitioner suggests that because a Court of Appeals can take judicial notice of a patent under certain circumstances the Fifth Circuit should have merely read the Higgins patent and, without reference to the three-fold factual inquiry required by *Graham, supra,* merely decided whether the Wollard patent was obvious or unobvious from a naked reading of the patent. That approach would ignore the mandate of *Graham, supra.* As wisely noted by the Fifth Circuit in *Kardulas* v. *Florida Machines Co.,* 438 F.2d 1118, 1124 (5th Cir. 1971):

> "Before a court concludes that it has no need for expert testimony to examine the nature of the prior art or the level of skill in the relevant industry, it should be convinced that the claimed invention would have been obvious even to ordinary laymen of modest intelligence. See Monaplastics, Inc. v. Caldor, Inc., 2 Cir. 1967, 378 F.2d 20, 21; Ronel Corp. v. Anchor Lock of Florida, Inc., 5 Cir., 1963, 325 F.2d 889, 890, cert. denied, 377 U.S. 924, 84 S.Ct. 1221, 12 L.Ed. 2d 216. To substitute our own judgment concerning the obviousness of the device as of December, 1960 'is to substitute our ignorance for the acquaintance with the subject of those who were familiar with it' at the time. Reiner v. I. Leon Co., 2 Cir., 1960, 285 F.2d 501, 504, cert. denied, 366 U.S. 929, 81 S.Ct. 1649, 6 L.Ed. 2d 388; *accord* Zero Manufacturing Co. v. Mississippi Milk Producers Association, 5 Cir., 1966, 358 F.2d 853, 857, cert. denied, 385 U.S. 841, 87 S.Ct. 93, 17 L.Ed. 2d 74."

Expert testimony was required and, indeed, relied upon by the District Court in determining the scope and content of the prior art, the differences between the prior art and the claims of the Wollard patent; and the level of skill in this art.

Petitioner's attack on the general standard of patentability applied by the Fifth Circuit in other cases is not

only irrelevant to the question of whether an erroneous standard of patentability was applied in this case, it is also inaccurate and misleading. For example, it is rather presumptuous of Petitioner to attempt to analogize a list of patent cases decided by the Fifth Circuit with the "gadgets" catalogued by Mr. Justice Douglas in *A. & P. Tea Co. v. Supermarket Corp.*, 340 U.S. 147, 156-158 (1950). In making that characterization, Mr. Justice Douglas discussed the closest prior art in each case, a task which Petitioner does not dare to undertake in its self-serving indictment of the Fifth Circuit.

Petitioner's assertion that the low standard of patentability being applied by the Fifth Circuit Court of Appeals is established by the fact that ". . . in the Fifth Circuit over 50% of patents have been held valid since this Court's landmark decision in *Graham* v. *John Deere Co.*, 383 U.S. 1, 18-19 (1966)" is not supported by a reference to any statistical authority.* Ironically, Petitioner's assertion that the last six patents considered by the Fifth Circuit were held valid is factually wrong. The patent considered by the Fifth Circuit in *Railex Corporation* v. *Speed Check Co.*, 457 F.2d 1040 (5th Cir. 1972) was held invalid under 35 U.S.C. 103 contrary to the statement which appears in the Petition (Petition, p. 11). Furthermore, the Fifth Circuit's decision in *Ziegler* v. *Phillips Petroleum Co.*, —— F.2d ——, 177 U.S.P.Q. 481 (5th Cir. 1973) did not involve an issue of patentability under 35 U.S.C. 103.

Finally, Petitioner's statistical argument overlooks the fact that over the past four years this Court has denied no less than eleven petitions for writ of certiorari seeking review of decisions of the Fifth Circuit Court of Appeals

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*Dunner, et al., *Patent Law Perspectives*, Vol. 4, Appendix 2 indicates that as of March, 1971 the Fifth Circuit had held valid 45.9% of the patents which it considered. Both the Sixth and Seventh Circuits have held a higher percentage of patents valid.

relating to the validity of patents.* Accordingly, this Court has had ample opportunity to monitor the standard of patentability being applied by the Fifth Circuit in situations where, unlike the present case, evidence pertaining to the three-fold factual inquiry of the *Graham* decision was in the record.**

2. The Fifth Circuit Did Not Depart from the Accepted Course of Judicial Proceedings in Adopting the District Court's Opinion.

In *Railex Corporation* v. *Speed Check Co.*, 457 F.2d 1040, 1042 (5th Cir. 1972) the Fifth Circuit had occasion to repeat its rule that:

> "We disapprove of the practice of the trial judge's *uncritically* accepting proposed findings, but this unfortunate practice does not erase the 'clearly erroneous' rule . . . When substantial evidence supports a finding it will not be found clearly erroneous merely because the expression of the finding was adopted from a proposal by counsel." (Emphasis added)

It is noteworthy that Judges Wisdom and Coleman participated in both *Railex, supra,* and the instant case.

The Court's attention is also respectfully directed to Local Rule 21 of the United States Court of Appeals for the Fifth Circuit. That rule establishes that the customary practice of the Fifth Circuit when it affirms a District Court

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* The most recent examples include *Deere & Co.* v. *Hesston Corp.*, 440 F.2d 904 (1971), cert. denied 404 U.S. 829; *Inject-O-Meter Co., Inc.* v. *North Plains Fertilizer & Chemical, Inc.*, 439 F.2d 1138 (1971) cert. denied 404 U.S. 824; *Hughes Tool Co.* v. *Ingersoll-Rand Co.*, 437 F.2d 1106 (5th Cir. 1971), cert. denied 403 U.S. 918.

** It is also noteworthy that the Petition does not challenge the manner in which the standard of patentability was applied with respect to the "Sandy".

decision without opinion is to merely state "AFFIRMED. See Local Rule 21". Yet, in this case the Fifth Circuit, despite its expressed disapproval of the practice of adopting findings prepared by counsel felt compelled to further state:

> "We adopted the opinion of the district court as the opinion of this Court."

The only reasonable conclusion which can be drawn from the action taken by the Fifth Circuit in this case is that its own critical analysis of the trial record and the findings which Respondents' counsel prepared and the District Court adopted led it to the belief that the findings fully and accurately reflected the record.

3. There Is No Issue of Law with Respect to Infringement.

Contrary to the assertions in the Petition the District Court clearly found, as a matter of fact, that inboard-power means were equivalent to outboard-power means in the context of the present invention and the Petitioner's boat, therefore, constituted an infringement. There is no other reasonable interpretation which can be placed on the District Court's decision (F.F. 19-28) particularly in view of its specific reliance on this Court's decision in *Graver Tank Co.* v. *Linde Air Products Co., supra,* in its conclusion of law on the issue of infringement (C.L. 5).

Petitioner's suggestion that the District Court "expressly refused" to find that inboard-power means are equivalent to out-board-power means is a distortion of the record. The District Court merely found it unnecessary to decide which of the conflicting theoretical reasons for the successful operation of both Petitioner's and Respondents' boats was correct because both boats had the same essential structure and accomplished the same result and Petitioner's expert had acknowledged that the same theory of operation would be applicable to both boats (F.F. 39).

In *Graver Tank Co.* v. *Linde Air Products Co.*, *supra*, this Court stated (at p. 609):

> "What constitutes equivalency must be determined against the context of the patent, the prior art, and the particular circumstances of the case. Equivalence in the patent law, is not the prisoner of a formula and is not an absolute to be considered in a vacuum." • • •
>
> "A finding of equivalance is a determination of fact."

The courts below clearly analyzed the context of the patent and the prior art (F.F. 26) and the particular circumstances of the case (F.F. 23, 27, 28) in reaching its conclusion that there was infringement. There is, accordingly, no issue of law for this Court to consider.

Conclusion

It is clear that there is no need for this Court to reiterate the rules of *Graham* v. *John Deere* or *Graver Tank Co.* v. *Linde Air Products Co.* since they have been properly considered and applied in this case.

The petition should be denied.

Respectfully submitted,

Alfred B. Engelberg
Amster & Rothstein
50 East 42nd Street
New York, New York 10017
Attorney for Respondents

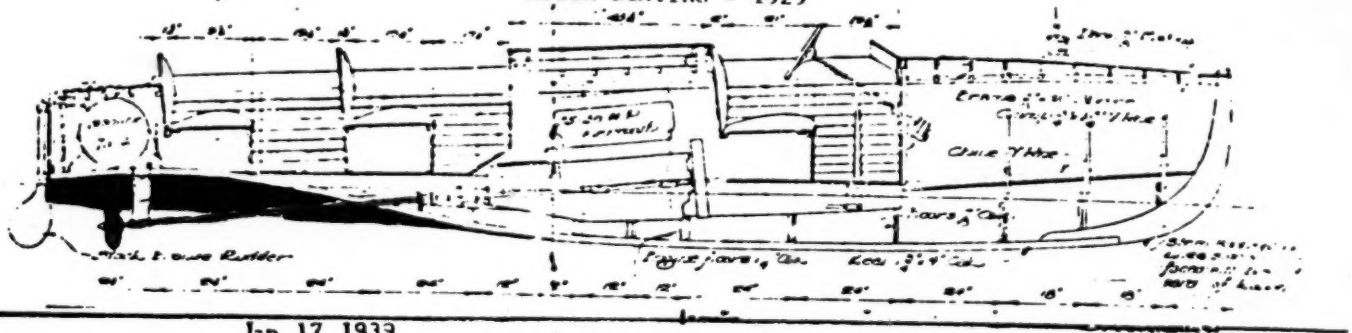
Of Counsel:

Morton Amster
Amster & Rothstein
New York, New York

APPENDIX

Sandpiper (Sandy)

MOTOR BOATING - 1929



Jan. 17, 1933. A. J. HIGGINS 2,144,111

BOAT HULL CONSTRUCTION

Fig. 1.